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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/782,849

02/23/2004

Hiroko Okabayashi

249260US2

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01/23/2008

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

RANKINS, WILLIAM E

ART UNIT

PAPER NUMBER

4172

NOTIFICATION DATE

DELIVERY MODE

01/23/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/782,849	<b>Applicant(s)</b> OKABAYASHI ET AL.	
	<b>Examiner</b> WILLIAM E. RANKINS	<b>Art Unit</b> 4172	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 11-15 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/23/2004 and 4/30/2007</u> .                                 | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 11-15 and 18 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/17/2007.

A review of the claims and updated search necessitated the rejections below.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A host device does not fall under the statutory categories of invention.

2. Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As the modules structure is not further defined

they can be considered code per se and thus do not fall under any statutory category of invention..

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-6 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the present case a module is claimed with no defined structure to support its definition.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imaeda (2004/0204093) in view of Official Notice.

As per claim 1;

Imaeda discloses:

A host device exchanging information with a memory card, the host device comprising:

a charge management module configured to receive payment of a charge corresponding to an increased amount of a usable area if a capacity of the usable area of the memory card for saving user data is increased (paragraphs 0077 and 0080), and

a transmission module configured to transmit an area changing command to instruct an increase or a reduction of the usable area in accordance with the charge to the memory card (paragraph 0076).

Imaeda does not disclose:

pay out a charge corresponding to the reduced amount of the usable area if the capacity of the usable area is reduced; and

However, the examiner takes official notice that it is old and well known to issue a credit when prescribed usage is reduced. As an example, wireless phone service providers will issue a credit when a calling plan is reduced. Likewise, a storage facility may issue a credit when a smaller storage space is desired over a currently used larger space.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the systems of Imaeda and Examiner's Official Notice. One of ordinary skill in the art would have been motivated to do reduce the cost to the consumer thereby making the product more attractive.

As per claim 2;

Imaeda discloses:

The host device of claim 1, further comprising:

a capacity calculation module configured to calculate the capacity of the usable area of the memory card (paragraph 0068).

As per claim 3;

Imaeda does not disclose:

The host device of claim 1, wherein the area changing command changes the capacity of the usable area of the memory card, and a capacity of an unusable area set in the usable area.

However the examiner asserts that, as the amount of available memory is not infinite, any change in the usable capacity of the memory card will result in a change in the unusable capacity of the memory card. Therefore, it would have been obvious to one of ordinary skill in the art to change the capacity of both the usable and unusable areas.

As per claim 4;

Imaeda discloses:

The host device of claim 1, wherein the area changing command changes a capacity of a security area to be accessed only when the host device of the memory card is authenticated (paragraph 0065-0067).

As per claim 5;

Imaeda discloses:

The host device of claim 1, further comprising: a connection module configured to notify a change of the capacity of the usable area to a memory capacity management server which manages a current capacity of the usable area of the memory card through a communication network (abstract, 'capacity...set from a cellular phone')

As per claim 6;

Imaeda discloses:

A memory card comprising: a usable area for saving a user data; and a controller for changing a capacity of the usable area in accordance with an area changing command to instruct an increase or a reduction of the usable area based on a charge, the command being transmitted from a host device which receives payment of a charge corresponding to an increased amount of the usable area if the usable area is increased (abstract, paragraphs 0076 and 0077), and

Imaeda does not disclose:

pays out a charge corresponding to a reduction of the usable area if the usable area is reduced.

However, the examiner takes Official Notice as used against claim 1.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the systems of Imaeda and Examiner's Official Notice. One of ordinary skill in the art would have been motivated to do reduce the cost to the consumer thereby making the product more attractive.

Claim 7 is rejected based upon the same rationale used in the rejection of claim 3.

As per claim 8;



Imaeda does not disclose:

The memory card of claim 6, wherein the controller temporarily saves the user data in a part of the unusable area.

However, the examiner takes Official Notice that it is old and well known to store data in temporary locations during data transfer operations for file security purposes.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the systems of Imaeda and Examiner's Official Notice. One of ordinary skill in the art would have been motivated to do so in order to provide a backup file in the event that the transmission failed.

As per claim 9;

Imaeda discloses:

The memory card of claim 6, further comprising: a security area to be accessed only when two-way authentication with the host device is carried out and the host device is authenticated, wherein the controller changes a capacity of the security area in accordance with the area changing command (paragraph 0039).

As per claim 10;

Imaeda does not disclose:

The memory card of claim 6, wherein the card is 24x32x2.1 mm in size and has a copyright protection function compliant with an SDMI standard.

Art Unit: 4172

However, the examiner takes Official Notice that it was old and well known in the art at the time of this invention to use memory cards of 24 x 32 x 2.1 mm and which were SDMI compliant.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William E. Rankins whose telephone number is 571-270-3465. The examiner can normally be reached on M-F 7:30 AM - 5:00 PM, off alt Fridays beg 6/15/07.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William E Rankins/  
Examiner, Art Unit 4172

/THOMAS A DIXON/

Supervisory Patent Examiner, Art Unit 4172

Application/Control Number: 10/782,849  
Art Unit: 4172

Page 11